

**REMARKS**

Applicants have studied the Office Action dated September 8, 2003 and have made amendments to the claims. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-21 are pending. Claims 1-3 and 12 have been amended. Reconsideration and further examination of the pending claims in view of the above amendments and the following remarks is respectfully requested. In the Office Action, the Examiner:

- Rejected claim 12 under 35 U.S.C. § 112, second paragraph.
- Rejected claims 1 and 2 under 35 U.S.C. § 102(h) as being anticipated by *Yamada* (*Yamada*) (U. S. Patent No. 6,166,733).
- Rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Yamada* (*Yamada*) (U. S. Patent No. 6,166,733) in view of *Wang* (*Wang*) (U.S. Patent No. 6,028,603).
- Indicated that Claims 4-10 and 12 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.
- Allowed claims 11, and 13-21.

The Applicants respectfully submitted that the Examiner's objection and rejections have been overcome based on the aforementioned amendments to the claims and the following remarks.

### Allowable Subject Matter

Applicants thank Examiner Lewis for indicating that claims 11 and 13-21 are allowable over the art of record. Therefore, this amendment does not narrow the scope of claims 4 – 7 and 15 – 18 within the meaning of *Festo*<sup>1</sup>. Further, as noted above, the Examiner noted that claims 4-10 and 12 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph and to include all of the limitations of the base claim and any intervening claims. Claim 12 has been amended to overcome the Examiner's rejection under 35 U.S.C. § 112. Claim 12 contains only those limitations of originally filed claim 12 and has been amended for clarification only, and this amendment does not narrow the scope of claim 12 within the meaning of *Festo*<sup>2</sup> as well.

Claims 4-10 depend from claim 1. Applicants have amended claim 1 to overcome the Examiner's rejection under 35 U.S.C. § 102(b). Accordingly, Applicants respectfully submit that claims 4-10 and 12 are in condition for allowance, which allowance is respectfully requested.

### Overview of the Present Invention

The presently claimed invention is directed to a method and system for an information processing system with a display for presenting a graphical user interface for scrolling through at least part of a complete multimedia data set. The method and system receive a size of a complete data set and display a first scrollable region of indicators that represent the complete data set. The first scrollable region has a first marker to indicate a current selection from the complete data set. The method and

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<sup>1</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, No. 00-1543 (122 S. Ct. 1831; 2002 U.S. LEXIS 3818; 62 U.S.P.Q.2D (BNA) 1705)(Decided May 28, 2002).

<sup>2</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, No. 00-1543 (122 S. Ct. 1831; 2002 U.S. LEXIS 3818; 62 U.S.P.Q.2D (BNA) 1705)(Decided May 28, 2002).

system further display a second scrollable region of indicators that represent a subset of the complete data set in the first scrollable region. This subset contains less data than contained in the complete data set. The second scrollable region also contains a second marker that indicates the current selection from the complete data set. The method and system also display a third region that displays a current selection from the complete multimedia data set. The method and system further receive user input to move the second marker between a first indicator and a second indicator in the second scrollable region of indicators. In response to this input, the current selection in the third region is changed to correspond to a new selection from the complete multimedia data set that corresponds to the second indicator.

#### Claim Amendments

The Applicants have amended independent claim 1, to more clearly describe that the second scrollable region has indicators that represent a subset of the complete data set, with the subset containing less data than is contained in the complete data set. Support for this amendment is found in the specification at, for example, page 11, lines 5-8, page 15, lines 10-15, and FIGs. 3 and 6. No new matter was added.

Dependent claim 2 has been amended to more clearly describe that the second scrollable region is formed to illustrate an expansion of the subset of the complete data set as a geometric shape. Support for this amendment is found in the specification at, for example, page 10, lines 21-25 and FIG. 3. No new matter was added.

Dependent claim 3 has been amended to more clearly describe that "the second scrollable region has an edge adjacent to the third region, and the edge comprises a series of thumbnail images corresponding to Images included in the subset of the complete data set." Support for this amendment is found in the specification at, for example, page 13, line 16-17. No new matter was added.

Dependent claim 12 has been amended to correct a typographical error. Dependent claim 12 has been amended to depend from original claim 11. Originally submitted dependent claim 12 was erroneously stated to depend from claim 10.

Rejection under 35 U.S.C. §102(b) as being anticipated by Yamada

As noted above, the Examiner rejected claims 1-2 under 35 U.S.C. § 102(b) as being anticipated by Yamada. The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Yamada.<sup>3</sup>

To begin, Yamada is directed to an index indicator and index display method that displays a set of indexes (or records) that are sorted in an index bar. The Yamada indicator and method displays this index bar and an adjacent indicator bar, with the indicator bar including an indicator toggle. A user can slide the indicator toggle along the indicator bar, and a keyword pointer on the index bar (which contains the entire set of records) correspondingly moves so as to select a target record from among the entirety of the records sorted. Yamada, column 5, lines 51-61 and FIGs. 3, 7 and 8.

Of particular note in the Yamada disclosure is that as the user slides the indicator toggle along the indicator bar, the keyword pointer moves along the index bar, as is shown in FIG. 8 of Yamada. FIG. 8 illustrates a number of indicator toggle positions that are shown along with corresponding positions for the keyword pointer as the indicator toggle is moved through the number of different horizontal locations. The horizontal position of the keyword pointer in the index bar for these various positions is shown to be the same as the horizontal position of indicator toggle that the user moves.

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<sup>3</sup> See MPEP §2131 "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Emphasis Added) *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

This indicates that the indicator bar represents the same number of records or indicators as is represented in the index bar.

In contrast to the present invention as claimed by amended independent claim 1, Yamada does not teach, anticipate or suggest the claimed aspects of the present invention, which include "displaying a second scrollable region of indicators that represents a subset of the complete data set in the first scrollable region, the subset containing less data than is contained in the complete data set[.]"

Furthermore, as the Yamada disclosure teaches an indicator bar that reflects the same amount of data as is displayed in the index bar, the Yamada disclosure does not teach, suggest or make obvious a "scrollable region formed to illustrate an expansion or the subset of the complete data set as a geometric shape[.]" The geometric shapes of the Yamada disclosure as are shown, for example in FIGs. 3, 7 and 8 therein, are graphical figures that are part of the display.

In contrast to Yamada, the aspect of the present invention as claimed by amended claim 2 includes "displaying the second scrollable region formed to illustrate an expansion of the subset of the complete data set as a geometric shape selected from the group of geometric shapes consisting of trapezoids, rhombuses, triangles and rectangles." Illustrating this expansion advantageously facilitates the user's visualization of the portion of the complete data set that is represented by the indicators of the second scrollable region.

For the foregoing reasons, amended independent claim 1 distinguishes over the cited references. Claim 2 depends from claim 1 and includes all of the limitations thereof. Therefore claim 2 also distinguishes over cited references for at least the above reasons as well. Therefore, the Applicants respectfully assert that the rejection of these claims under 35 U.S.C. §102(b) should be withdrawn.

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Moran Reference In Light Of Amended Claims 1 and 2

Amended independent claim 1 and amended dependent claim 2 further distinguish over the *Moran et al.* reference, U. S. Patent Number 5,717,869 ("Moran"), which is made of record but was not relied upon in the present office action. Moran addresses a computer controlled system using a timeline to control playback of temporal data. Moran, Title. The Moran system is for capturing and controlling access to concurrently recorded timestreams of a session. A session is of a collaborative activity such as a meeting. Moran, Abstract. The use and purpose of the Moran invention is to view multiple views and soundtracks of a meeting. See, Moran, FIG. 11.

In contrast to the Moran reference, the present invention is directed to scrolling through a complete multimedia data set by displaying a first scrollable region of indicators that represent the complete data set and also displaying a second scrollable region of indicators that represent a subset of the complete data set. See, amended claim 1. Applicants respectfully submit that modification of the Moran reference to the application of the present invention destroys the intent, purpose and function of the Moran system. The Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such as proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Therefore, the Applicants respectfully submit that the cited references, including the references made of record by not relied upon by the Examiner, do not teach, suggest or make obvious the aspect of the present invention, as is claimed by amended claims 1 and 2.

Rejection under 35 U.S.C. §103(a) as Unpatentable over Yamada in view of Wang

As noted above, the Examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Yamada in view of Wang. The Examiner recites 35 U.S.C.

§103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." As discussed above, the Yamada reference does not teach the advantageous aspect of the present invention including that of displaying a second scrollable region of indicators that represents "a subset of the complete data set in the first scrollable region, the subset containing less data than is contained in the complete data set". This is a limitation of amended claim 1, from which amended claim 3 depends, and is therefore contained within amended dependent claim 3.

As noted by the Examiner, Yamada does not teach the *"edge comprising a series of thumbnail images corresponding to images included in the complete data set that are represented by the subset of indicators."* Office Action, Paper 4, page 4, section 7.

Dependent claim 3 has been amended to more clearly describe that the "second scrollable region has an edge adjacent to the third region, and the edge comprises a series of thumbnail images corresponding to images included in the subset of the complete data set." As defined by amended claim 1, from which amended claim 3 depends, the subset of data is the data that is represented by indicators in the second scrollable region.

In contrast to this aspect of the claimed invention, the Wang disclosure teaches displaying thumbnails for either an entire database or for an album, depending upon the type of icon that is selected. The cited references, taken either individually or in combination with one another, do not teach, suggest or make obvious an edge that comprises a series of thumbnail images that correspond to images included in the subset of the complete data set, as is presently claimed by amended claim 3.

Furthermore, Applicants respectfully assert that an attempted modification of Wang into a combination with the teachings of Yamada results in an inoperable combination. As discussed above, the Yamada reference and the Wang reference, taken either alone or in combination with each other, do not teach suggest or make obvious a "second scrollable region of indicators that represents "a subset of the complete data set in the first scrollable region, the subset containing less data than is contained in the complete data set". In light of this definition of a subset, Applicants respectfully submit that the teachings of Wang and Yamada, taken alone or in combination, do not include "displaying ... a series of thumbnail images corresponding to images included in the subset of the complete data set," as is claimed by amended claim 3. Described differently, the cited references cannot be made to operate by displaying indicators that represent a subset, and then displaying a series of thumbnails that correspond to those indicators. Combining the teachings of the Yamada and Wang references result in an image display area that would display thumbnail images corresponding to all of the complete dataset.

If references taken in combination would produce a "seemingly inoperative device," we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. In re Spinnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

Furthermore, amended claim 3 further depends from claim 1 and includes all of the limitations thereof. Therefore claim 3 also distinguishes over cited references for at least the above reasons as well. For at least the foregoing reasons, amended dependent claim 3 distinguishes over the cited references. Therefore, the rejection of amended dependent claim 3 under 35 U.S.C. §103(a) should also be withdrawn.



Conclusion

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.


Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.


In view of the foregoing, Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

**PLEASE CALL** the undersigned if that would expedite the prosecution of this application or if the Examiner finds the application other than in condition for allowance.

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